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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 040204

Application Number: 10/087,613
Filing Date: March 01, 2002
Appellant(s): KOBBEN ET AL.

Christopher B. Jacobs
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/15/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 14-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,873,809	Kempster	2-1999
4,032,133	Steffens	6-1977

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kempster et al. (US 5,873,809) in view of Steffens et al. (US 4,032,133).

Kempster et al. disclose a cushioning conversion machine comprising a frame; first and second rotating feed members 24 resiliently biased towards one another by springs; see figure 10. The lower feed member is driven and the upper is positioned upon an idler shaft. The members form a pinch force on the material fed between.

Kempster et al. do not disclose exactly how the biased members are mounted, however Steffens et al. teach rotating feed members 34, 48 in pivotal carriers 94, 96 mounted on pivots biased by biasing members/springs 80. The releasable locking device 90 resiliently holds the feed members/rollers 34, 48 in position in a locked position. When released/unlocked, it allows for pivoting away in case of a paper jam etc. see column 4, lines 35-38.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the rotating members as taught by Steffens in the invention of Kempster et al. in order to provide biasing towards one another.

Regarding claim 22, the Examiner takes OFFICIAL NOTICE that it further would have been obvious to one of ordinary skill in the art to substitute a leaf spring for the coil spring as they are recognized in the art as obvious variants.

(11) Response to Argument

In response to appellant's argument that Steffens is nonanalogous art, it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Steffens is concerned with positioning rotating roller members for a buckle-type paper folding machine, which is directly applicable to he appellant's field of producing dunnage with a paper web by rotating members.

In response to appellant's argument that only one gear of Kempster is adjustable, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The "adjustment problem" is addressed by appellant by pivoting the first rotating feed member away from the second rotating feed member (claim 14). Because Kempster lacks an express teaching of how the one gear/feed member is adjusted, one of

ordinary skill in the art could have looked to Steffens for a teaching of adjustability for rotating feed members in a web folding operation.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Steffens recognizes an "object of the present invention is to provide a roller positioning method and apparatus which permits ready adjustment of the spacing between the rollers", column 2, lines 21-23; and biasing to handle "an unexpected thickness", see column 4, lines 28-32.

Regarding arguments concerning the locking device, as noted above, Steffens teaches releasable locking device 90, which resiliently holds the feed members/rollers 34, 48 in position in a locked position. When released/unlocked, it allows for pivoting away in case of a paper jam etc. see column 4, lines 35-38.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Chris Harmon
April 2, 2004

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